

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended, is respectfully requested.

Claims 1-45 are pending in this application. Claims 1, 15, 29, and 43-45 have been amended without the addition of any new matter to change “another” to -- second --. Claims 1, 15, and 29 have been further amended without the addition of any new matter to better define the member that obstructs feeding of the second sheet or original document together with the first sheet or original document as supported by the description in the specification at page 13, lines 3-19, for example. Claims 7, 21, and 35 have been amended without the introduction of any new matter in the manner suggested by the outstanding Action. Claim 37 has been amended without the addition of any new matter to correct a typographical error.

The outstanding Office Action presents an objection to Claims 2, 6-11, 16, 20-25, 31, and 34-35 under 37 CFR § 1.75(i), an objection to the recital of “the another sheet,” a rejection of Claims 7, 21, and 35 under the second paragraph of 35 U.S.C. § 112, and a rejection of Claims 1-45 under 35 U.S.C. § 103(a) as being unpatentable over Byeon et al. (U.S. Patent No. 6,381,441, “Byeon”) in view of Hirota et al. (U.S. Patent No. 6,206,359, “Hirota”).

The objection to Claims 2, 6-11, 16, 20-25, 31, and 34-35 under 37 CFR § 1.75(i) is first noted to be improper as this rule sets forth a mere suggestion, “should,” not a requirement, “must.” In any event, the present listing of Claims presents line indentations between elements of Claims 2, 6-11, 16, 20-25, 31, and 34-35. Accordingly, withdrawal of this objection is respectfully requested.

The objection to Claim 1 is believed to be overcome by the present amendment that eliminates the word “another” from the objected to language (“the another”) in Claim 1 and

also from Claims 15, 29, and 43-45. Accordingly, withdrawal of this objection is respectfully requested.

The rejection of Claims 1-45 under 35 U.S.C. § 103(a) as being unpatentable over Byeon in view of Hirota is respectfully traversed.

Turning first to independent Claims 1, 15, and 29, the previous recitals by these claims of the member that obstructs feeding of the second sheet (Claim 1) or second original document (Claims 15 and 29) together with the first sheet (Claim 1) or original document (Claims 15 and 29) has been changed to require a “roller” that rotates in a specified direction to “prevent feeding of the second sheet together with the first sheet” (Claim 1) or to “prevent feeding of the second original document together with the first original document” (Claims 15 and 29). As noted above, this change is clearly supported by the original specification disclosure at page 13, lines 3-19, for example.

Neither Byeon nor Hirota, considered alone or together in any proper combination teach this amended subject matter of independent Claims 1, 15, and 29. Accordingly, no *prima facie* case of obviousness¹ based upon the teachings of Byeon and/or Hirota can be said to exist, and withdrawal of this 35 U.S.C. § 103(a) rejection of independent Claims 1, 15, and 29 is respectfully requested.

As Claims 2-14 depend directly or indirectly from independent Claim 1 so as to incorporate all of its limitations, Claims 16-28 depend directly or indirectly from independent Claim 15 so as to incorporate all of its limitations, and Claims 30-42 depend directly or indirectly from independent Claim 29 so as to incorporate all of its limitations, dependent Claims 2-14, 16-28, and 30-42 all patentably define over the applied references for at least the same reasons as their respective parent independent claim. In addition, Claims 2-14, 16-28, and 30-42 all add features to their respective parent independent claim that are not taught

¹ It is well established that a *prima facie* case of obviousness requires that all claim limitations be considered and demonstrated to be taught or suggested by the prior art, see MPEP §2143.03

or suggested by Byeon and/or Hirota, considered alone or together in any proper combination and are respectfully submitted to patentably define over these references for this reason as well.

Accordingly, withdrawal of the rejection of Claims 2-14, 16-28, and 30-42 as being unpatentable over Byeon in view of Hirota under 35 USC § 103(a) is also respectfully requested.


Claims 43-45 are all independent claims and all require a “means for obstructing feeding of the second sheet” that is clearly a limitation that invokes the sixth paragraph of 35 U.S. C. § 112. This “means for obstructing feeding of the second sheet” finds corresponding structural support relative to roller 10 described at page 13, lines 3-19 of the specification. It is well established that the broadest reasonable interpretation that an examiner may give such a means-plus-function limitation in a pending application is the interpretation statutorily mandated by the sixth paragraph of 35 U.S.C. § 112. *See in re Donaldson Co.*, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). Further in this regard, the PTO reviewing court recently emphasized that the PTO must explain why it considers the “‘means’ disclosed in the specification [to be] structurally equivalent to that embodied in [the reference].” *See Gechter v. Davidson* 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997). No such reasonable finding is possible here and withdrawal of the rejection of Claims 43-45 as being unpatentable over Byeon in view of Hirota under 35 USC § 103(a) is also respectfully requested.

Application No. 10/781,917
Reply to Office Action of 04/19/2007

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'James J. Kulbaski', is written over a horizontal line.

James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Raymond F. Cardillo, Jr.
Registration No. 40,440

I:\ATTY\RFC\24\248233-AM.DOC